

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed March 24, 2003. Applicants respectfully request reconsideration and favorable action in this case. Additionally, Applicants wish to note that the Examiner failed to indicate in the Detailed Action whether the Examiner rejects Claim 31, and if so, the grounds on which he does. Applicants add Claim 32.

Section 103 Rejections

The Examiner rejects Claims 1-2, 4-10, 12-17, 18-22, and 23 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,317,414, issued to Naohiro ("*Naohiro*"). In the rejection, the Examiner further refers to material from U.S. Patent No. 4,736,465 issued to *Bobey et al.* ("*Bobey*"). Therefore, Applicants address this reference in connection with the Examiner's § 103 rejection.

Claim 1 discloses, in an ATM network having a plurality of paths to a common destination, a method comprising:

- receiving ATM traffic from a traffic source as a plurality of copies of traffic routed along a plurality of paths, each one of the paths having a receive circuit;
- configuring an ATM switch to provide a route to a common destination for each one of the paths;
- determining a qualified copy of the traffic; and
- discarding all copies of the traffic except for the qualified copy such that only the qualified copy is passed to the ATM switch for routing to the common destination.

Applicants submit that *Naohiro* and *Bobey*, taken alone or in combination, fail to teach, disclose, or suggest all elements of this Claim. For example, Claim 1 includes "discarding all copies of the traffic except for the qualified copy such that only the qualified copy is passed to the ATM switch for routing to the common destination." The Examiner contends that this element of Claim 1 would be obvious in light of *Naohiro*. However, the Examiner bases this contention on the belief that *Naohiro* discloses a signal switching method and apparatus in which "only one signal [is] chosen to be sent *through* the ATM switch." (emphasis added) Office Action, ¶ 3. This mischaracterizes the language of Claim 1. Specifically, Claim 1 teaches, *inter alia*, "discarding all copies of traffic except for the

qualified copy *such that only the qualified copy is passed to the ATM switch.*" (emphasis added) Moreover, *Naohiro* does not explicitly include every limitation of Claim 1.

Furthermore, to establish a prima facie case of obviousness, there must be some suggestion or motivation to modify the prior art reference. M.P.E.P. § 2143.01. Not only does *Naohiro* fail to suggest any modification that might yield a method under which "only the qualified copy is passed to the ATM switch", *Naohiro*, in fact, expressly teaches away from such a modification. Figure 1 of *Naohiro* clearly shows both virtual paths (VP1 and VP2) reaching VP switch 5-7. The text of *Naohiro* provides additional support for this reading. ("The method and apparatus are configured to execute a *switching to a spare route from a plurality of routes in current use* in an ATM network, . . ." (emphasis added) Col. 4, ll. 55-59.) *Naohiro* clearly does not reduce traffic *at the switch* as the elements of Claim 1 do. Thus, *Naohiro* fails to disclose, teach, or suggest every limitation of Claim 1.

In rejecting Claim 1, the Examiner additionally relies on *Bobey* to teach "discarding". The Examiner admits, at Office Action, ¶ 3, that *Naohiro* does not teach "discarding" in general. Furthermore, as noted above, *Naohiro* fails to teach discarding "such that only the qualified copy is passed to the ATM switch." The Examiner fails to address this omission and no disclosure can be found in *Bobey* to correct this deficiency. In fact, the node in *Bobey* expressly receives multiple copies of transmitted traffic. ("In general, each node will receive two copies of each packet . . ." Col. 5, ll. 23 – 25). Thus, combination with *Bobey* does not remedy the omissions of *Naohiro*. Consequently, *Naohiro* and *Bobey*, both alone and in combination, fail to teach every element of Claim 1. For at least these reasons, Claim 1 is allowable. Therefore, Applicants respectfully request reconsideration and allowance of Claim 1 and its dependents.

Although of varying scope, Claims 9, 16, 24, and 31 contain elements that, for reasons substantially similar to those discussed above with respect to Claim 1, are absent from *Naohiro* and *Bobey*. Applicants thus request reconsideration and allowance of Claims 9, 16, 24, and 31 and their dependents.

New Claims Added

Applicants add new Claim 32, which is fully supported by the originally filed specification. New Claim 32 includes elements substantially similar to allowable Claims 1-31. Applicants request full allowance of these claims for at least this reason.

Conclusions

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending Claims. If the Examiner feels that a telephone conference or an interview would advance prosecution of this Application in any manner, the undersigned attorney for Applicants stands ready to conduct such a conference at the convenience of the Examiner.

A check in the amount of \$102.00 is enclosed to cover the fee for the additional independent claim. No other fees are believed to be due, however, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.
Attorneys for Applicants



Kurt M. Pankratz
Reg. No. 46,977

2001 Ross Avenue, Suite 600
Dallas, Texas 75201-2980
(214) 953-6584

Date: 6/24/03

CORRESPONDENCE ADDRESS:
Customer Number or Bar Code Label:

